



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

3764
#5
4/12/11/03

In re application of: Morris et al.

Serial No.: 09/954,759

Group No.: 3764

Filed: Sept. 18, 2001

Examiner: D. DeMille

For: PORTABLE, SELF-CONTAINED APPARATUS FOR DEEP VEIN THROMBOSIS
(DVT) PROPHYLAXIS

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED
JAN 16 2003
TECHNOLOGY CENTER R3700

Dear Sir:

In response to the Office Action mailed November 4, 2002, the Examiner's attention is directed to the following remarks.

REMARKS

Claims 21-50 remain pending in this application and all are being resubmitted in unamended form on the grounds that the Examiner has failed to establish *prima facie* obviousness.

All of the claims stand rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,290,662. Applicants respectfully disagree with this determination, and request that the Examiner provide an explanation as to why it would have been obvious to "leave out the details." Until such justification is provided, the need for a terminal disclaimer will be held in abeyance.

Claims 21-28, 32-34 and 37-50 stand rejected under 35 U.S.C. §103(a) over Taheri et al. ('458). It is clear that the Examiner is using the wrong standard for the purposes of rejection, basing his opinion on personal speculation as opposed to any actual *teachings from the prior art*. The Examiner makes copious use of the word "clearly" in an attempt to be more convincing, but the fact remains that the cited references do not even suggest what the Examiner contends they disclose.

The Examiner concedes that Taheri et al. is "silent with regard to whether or not the fabric outer shell is inelastic or not," but argues that "clearly the fabric outer shell would have to be inelastic [for] if